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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/028,825	12/28/2001	Kimihito Yamasaki	4074-2	5543
23117 7590 05/17/2007 NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON, VA 22203			EXAMINER TRAN, MAI T	
			ART UNIT 2129	PAPER NUMBER
			MAIL DATE 05/17/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/028,825	YAMASAKI ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Mai T. Tran	2129	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 20 February 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicants' submission filed on February 20, 2007 has been entered.

Claims 1, 2, 6, 7, 8, and 9 have been amended. No new claims have been added. Claims 1-9 remain pending in the application and which have been fully considered by the examiner.

### **PRIORITY**

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### **CLAIM REJECTIONS - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsuzaki et al (U. S. Patent No. 5,357,439), hereafter Matsuzaki, as applied to claims 1-9 in the previous Office Action, and further in view of Jerome D. Johnson (U. S. Patent No. 5,625,776), hereafter Johnson.

Matsuzaki teaches substantially all of applicants' claimed invention (see Office Action dated March 8, 2006 from page 3 to page 9). Matsuzaki fails to disclose "*a composite apparatus which is a copying machine, a facsimile machine, a printing machine, or a composite machine comprising multiple of said machines.*"

Johnson teaches a system to generate customized proposals for computers, related peripherals, and copy machines (Johnson, col. 1, lines 20-21, col. 5, lines 1-3, lines 14-16).

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to combine Matsuzaki with Johnson.

The motivation for doing so would be to customized each proposal for a particular customer, each proposal will have a much more persuasive effect in selling the product. Also, if any information about the product changes, such as prices of options, the system information stored in a database may be simply changed in order to accommodate the new information (Johnson, col. 2, lines 40-45).

## **RESPONSE TO ARGUMENTS**

### **Rejection under 35 U.S.C. §103(a)**

Applicants' arguments filed have been fully considered but they are not persuasive.

Specifically, applicants argue that:

### **Argument 1**

Matsuzaki fails to disclose or suggest the above italicized features of claim 1. Matsuzaki relates to a system for a toy plane, and has nothing to do with ordering a copying machine, a facsimile machine, a printing machine, or a composite machine comprising multiple of said machines, through an ordering apparatus as recited in claim 1. Recognizing this flaw in Matsuzaki, the Office Action cites to Johnson.

However, Johnson and Matsuzaki are entirely unrelated and deal with drastically different subject matters and are not properly combinable. They are non-analogous. Matsuzaki relates to a manufacturing system which accepts custom orders for products such as toy planes. On the other hand, Johnson relates to a proposal preparation system for selling computer equipment. The two references are non-analogous and are not properly combinable under Section 103(a). There is no suggestion or motivation in the cited art for the alleged combination. Hindsight is not permitted.

In response, Examiner disagrees. First, Matsuzaki teaches the above italicized features of claim 1 "*when said composite apparatus is set up and the power is switched on*" at col. 7, lines 1-20, specifically lines 4-5, where it stated "1-10 denotes a combination design unit which

designs the product based on the specification required by a customer.” Examiner asserts the product designed by a combination design unit reads on composite apparatus is set up. Second, Examiner interprets electrical power provided from any electrical source such as Power Company is inherent in the cited reference. Matsuzaki teaches a manufacturing system and manufacturing method. One would assume a manufacturing system would use electrical power to function vs. by hand and is related to electrical apparatus. Therefore, the power is switched on is inherent. Third, Matsuzaki teaches “a toy plane” as an **example of a product being manufactured** (col. 9, lines 53-54). Matsuzaki teaches the entire claimed invention as well.

In response to applicants’ argument that Johnson is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Matsuzaki and Johnson are both in the field of applicants' endeavor, which are customized composite apparatuses. Matsuzaki teaches custom-made manufacturing system and custom-made manufacturing method for various kinds of products. However, Matsuzaki is silent about those various kinds of products comprise a copying machine, a facsimile machine, a printing machine, or a composite machine comprising multiple of said machines as applicants' claim. Johnson, on the other hand, teaches customized product proposals for selling computer equipment and copy machines. Therefore, the combination of the two references is appropriate and the rejection is maintained.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on

obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

### **Argument 2**

Moreover, claim 1 has been clarified to require that the composite apparatus recognizes unit information for specifying units to be composed itself, and create composite state information for specifying a composite state of units based on the recognized unit information, according to the same rule as said predetermined rule, *when said composite apparatus is set up and the power is switched on*. E.g., see pg. 21, lines 1-10. The cited art cannot possibly disclose or suggest these features, especially being performed when the composite apparatus is set up and the power is turned on as required by amended claim 1.

In response, Examiner disagrees. First, Matsuzaki teaches the above italicized features of claim 1 “*when said composite apparatus is set up and the power is switched on*” at col. 7, lines 1-20, specifically lines 4-5, where it stated “1-10 denotes a combination design unit which designs the product based on the specification required by a customer.” Examiner asserts the product designed by a combination design unit reads on composite apparatus is set up. Examiner interprets electrical power provided from any electrical source such as Power Company is inherent in the cited reference. Matsuzaki teaches a manufacturing system and manufacturing method. One would assume a manufacturing system would use electrical power to function vs. by hand and is related to electrical apparatus. Therefore, the power is switched on is inherent.

### **Argument 3**

Art Unit: 2129

Additionally, *both* Matsuzaki and Johnson fail to disclose or suggest (a) causing said composite apparatus (which is the copying machine, the facsimile machine, the printing machine, or the composite machine comprising multiple of said machines) to *inform the composite state information to said ordering apparatus*; and (b) *comparing the composite state information created by said ordering apparatus and the composite state information informed by said composite apparatus*, as required by claim 1. Nothing in Matsuzaki or Johnson discloses or suggests these features of claim 1. Thus, even the alleged combination of the two references fails to meet the claim in these respects.

Johnson appears to disclose selecting parts and assembling thereof on a monitor display, which is a simulation for so-called BTO. On the other hand, the Examiner has admitted that Matsuzaki's toy plane is not a composite apparatus. However, the Examiner contends that composite state information is compared between "an ordering department" and "a designing department" of Matsuzaki. Applying these contentions to claim 1, the order for units constituting the designing department should be received by the ordering department. However, it is apparent that in Matsuzaki the receiving department does not receive an order for units constituting the designing department, by an order for units constituting a toy plane.

In response, Examiner disagrees. Both Matsuzaki and Johnson when combine, teach (a) causing said composite apparatus (Matsuzaki, col. 2, lines 10-15) (which is the copying machine, the facsimile machine, the printing machine, or the composite machine comprising multiple of said machines – Johnson, col. 1, lines 20-21, col. 5, lines 1-3, lines 14-16) to inform the composite state information to said ordering apparatus (Matsuzaki, col. 2, lines 10-11); and (b) comparing the composite state information created by said ordering apparatus and the composite state information informed by said composite apparatus (Matsuzaki, col. 3, lines 14-19).

#### **Argument 4**

On the other hand, claim 1 requires causing said composite apparatus to recognize unit information for specifying units to be composed itself. That is, according to claim 1, the composite apparatus exists and itself recognizes unit information which specifies units making up itself - this feature is not disclosed or suggested in any of the cited art. Thus, the Examiner's position is inappropriate and the rejection should be withdrawn. The rejection is fundamentally flawed.

In response, Examiner disagrees. Matsuzaki teaches at col. 7, lines 1-20, specifically



lines 4-5, where it stated “1-10 denotes a combination design unit which designs the product based on the specification required by a customer.” Examiner asserts the combination design unit reads on the composite apparatus.

#### **Argument 5**

If one were to assume that the toy plane of Matsuzaki does not constitute a composite apparatus as alleged by the Examiner, then according to the Examiner the design department would be constituted in accordance with the order received by the ordering department - this clearly does not occur in Matsuzaki. That is, in Matsuzaki, the ordering department does not receive an order for units constituting the design department, but instead receives orders for units constituting toy planes.

Accordingly, if the composite apparatus in Matsuzaki is the toy plane (most appropriate), then the cited art does not meet the claim at least because the toy plane itself in Matsuzaki does not recognize unit information which specifies units making up the toy plane. On the other hand, if the toy plane is not the composite apparatus in Matsuzaki (less appropriate) as alleged by the Examiner (and the design department is a composite apparatus as alleged by the Examiner), then the claim cannot possibly be met because the design department is not constituted in accordance with the order received by the ordering department.

Applicants are ambiguous by clouding the issue i.e. attacking the prior art in general and in circle. Therefore, it does not convey the applicants' rationale such that the Examiner can respond in a meaningful manner. Applicants are respectfully requested to present exactly which limitation in which claim that Matsuzaki does not meet so that Examiner can response.

#### **Argument 6**

Additionally, all pending claims require that a particular function(s) is performed *when said composite apparatus is setup and the power is switched on*. The cited art fails to disclose or suggest this, either taken alone or in the alleged combination.

In response, Examiner disagrees. First, Matsuzaki teaches the above italicized features of all pending claims that a particular function(s) is performed "*when said composite apparatus is set up and the power is switched on*" at col. 7, lines 1-20, specifically lines 4-5, where it stated "1-10 denotes a combination design unit which designs the product based on the specification required by a customer." Examiner asserts the product designed by a combination design unit reads on composite apparatus is set up. Second, Examiner interprets electrical power provided from any electrical source such as Power Company is inherent in the cited reference. Matsuzaki teaches a manufacturing system and manufacturing method. One would assume a manufacturing system would use electrical power to function vs. by hand and is related to electrical apparatus. Therefore, the power is switched on is inherent.

#### **Argument 7**

Furthermore, regarding claim 4, both Matsuzaki and Johnson fail to disclose or suggest "means for comparing the transmitted composite state information and the composite state information corresponding to the composite apparatus information stored by said storing means" as required by claim 4. Because both references fail to disclose or suggest this feature, even the alleged combination fails to meet the invention of claim 4 in this respect.

In response, Examiner disagrees. Matsuzaki teaches means for comparing the composite state information created by said ordering apparatus and the composite state information informed by said composite apparatus (Matsuzaki, col. 3, lines 14-19).

#### **Argument 8**

Regarding claim 5, both Matsuzaki and Johnson fail to disclose or suggest "*means for comparing the composite state information transmitted from said ordering apparatus and the composite state information transmitted from said composite apparatus*" as required by claim 5. Because both references fail to

disclose or suggest this feature, even the alleged combination fails to meet the invention of claim 5 in this respect.

In response, Examiner disagrees. Matsuzaki teaches means for comparing the composite state information created by said ordering apparatus and the composite state information informed by said composite apparatus (Matsuzaki, col. 3, lines 14-19).

#### **Argument 9**

Furthermore, regarding claim 7, both Matsuzaki and Johnson fail to disclose or suggest "*comparing received composite state information and the composite state information stored in said storing means*" as required by claim 7. Because both references fail to disclose or suggest this feature, even the alleged combination fails to meet the invention of claim 7 in this respect.

In response, Examiner disagrees. Matsuzaki teaches "comparing received composite state information and the composite state information stored in said storing means" (Matsuzaki, col. 3, lines 7-25).

#### **Argument 10**

Additionally, regarding claims 8-9, these claims also require *comparing received composite state information and the stored composite state information*. Again, both Matsuzaki and Johnson fail to disclose or suggest this feature of claims 8-9. Because both references fail to disclose or suggest this feature, even the alleged combination fails to meet the invention of claims 8-9 in this respect.

In response, Examiner disagrees. Matsuzaki teaches "comparing received composite state information and the stored composite state information" (Matsuzaki, col. 3, lines 7-25).


### CORRESPONDENCE INFORMATION

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mai T. Tran whose telephone number is (571) 272-4238. The examiner can normally be reached on M-F 9:00am-- 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Vincent can be reached on 571-272-3080. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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